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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,521	09/22/2003	Priyadarsan Patra	2207/1254202	5814

7590 01/18/2006
B. Delano Jordan
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12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025

EXAMINER

DO, THUAN V

ART UNIT	PAPER NUMBER
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2825

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/665,521		PATRA ET AL.	
	Examiner		Art Unit	
	Thuan Do		2825	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 18, 20, 21, 23, 24 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18, 20, 21, 23, 24 and 26 is/are allowed.
- 6) ☒ Claim(s) 1 and 10-13 is/are rejected.
- 7) ☒ Claim(s) 2-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/22/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to application filed on 09/22/2003. Claims 1-13,18,20,21,23,24,26 are pending in this office action. Claims 14-17,19,22,25,27 are canceled.

Double Patenting

Claim 1 is rejected on the ground of nonstatutory double patenting over claim1 of U. S. Patent No. 6721924 since the claim, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as a portion of claim 1 of Patent No. 6721924.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim objections

Claim 1, the terms "objective parameters" and "noise constraints" are unclear to what applicants intend to mean. Clarification or correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1,10-13 are rejected under 35 U.S.C. 102(e) as being unpatentable over Conn et al. Pat. No. 5999714.

Regarding claim 1: Conn teaches a method comprising:

determining a set of objective parameters for the circuit (col. 5, lines 1-39);

receiving noise constraints for the circuit (col. 5, lines 1-39); and

optimizing values of the objective parameters based on the noise constraints(col. 5, lines 1-39).

Regarding claim 10: Conn teaches a method with:

receiving timing constraints for the circuit (col. 5, lines 1-39); and

optimizing the objective parameters values based on the timing constraints (col. 5, lines 1-39).

Regarding claim 12: Conn teaches a method with:

receiving timing constraints for the circuit (col. 5, lines 1-39); and

optimizing the objective parameters values based on the timing constraints (col. 5, lines 1-39).

The remaining claims of 102(e) section contain features similar to the rejection of claims 1,10,12 and rejected in the rationale.

Allowable Subject Matter

Claims 2-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The reason for allowance is that the prior art of

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record does not teach the dependent claims with all other features of independent claim.

Allowable Subject Matter

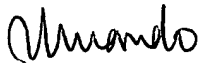
Claims 18,20,21,23,24,26 are allowed. The reason for allowance is that the prior art of record fails to teach the combination of all features of each independent claim.

CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuan Do whose telephone number is 571-272-1891. The examiner can normally be reached on Monday-Friday 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Chiang can be reached on 571-272-7483. The fax phone numbers for proceeding this application is 571 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0596.



Thuan Do
Primary examiner
01/02/2006